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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,361	12/31/2003	Nelson Minar	16113-001001 GP-064-07-US	4924
26192 7590 09/29/2008 FISH & RICHARDSON P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022				
EXAMINER				
CHAMPAGNE, DONALD				
ART UNIT		PAPER NUMBER		
3688				
NOTIFICATION DATE		DELIVERY MODE		
09/29/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Office Action Summary

Application No.

10/750,361

Applicant(s)

MINAR, NELSON

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-55 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 31 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date 5 sheets.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application.
6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-46 are rejected under 35 U.S.C. 101 because the claimed invention is directed to nonstatutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claims 1-46 fail to meet the above requirements because the claims fail to tie in another statutory class of invention.

Applicability of 35 USC 112, 6th Paragraph

3. It appears the applicant is attempting to invoke 35 U.S.C. 112, 6th paragraph in claims 47-55 by using "means-plus-function" language, such as "means for receiving", for which the examiner can find no support in the specification. In order to successfully invoke the sixth paragraph, a three-prong test must be met (MPEP § 2181.I): (1) the claim must use means-plus-function language; (2) the claim itself must not provided structural limitations to the means-plus-function language; and (3) the specification must recite explicit physical structural limitations for the means-plus-function language in the claim.
4. While the above claims pass the first two prongs of the three prong test, they do not pass the third prong: There is no explicit recitation in the specification of any physical structures to perform the functions of the means-plus-function limitations in the claims. For example, example "means for storage" at spec. pp.8-9, but an example does not explicitly limit the claims. No structure whatsoever was found for either "means for comparing" or "means for

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applying". Therefore, 35 U.S.C 112, 6th paragraph has not been successfully invoked. The Examiner will consider the means to perform the claimed functions as any means, physical or virtual, that can perform the function.

Claim Rejections - 35 USC § 102 and 35 USC § 103

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-20, 23, 24, 26-30, 33-51 and 53-55 are rejected under 35 U.S.C. 102(b) as being anticipated by Sheth et al. (US006311194B1, hereafter "Sheth").

8. Sheth teaches (independent claims 1, 38 and 47) a method and system of generating information including targeted ads (col. 16 lines 37-55), the method comprising:

receiving information in a format (*an XML string*);

receiving a first targeted ad (*a semantically targeted advertisement*) from an automated ad server system;

combining the first targeted ad with the received information (*the content provider is able to tailor the advertisements in their own page*) to generate a set of response information which is also in a syndicated format.

9. The limitation "a syndicated format" is non-functional descriptive material (either printed matter or software) and was not given patentable weight (MPEP § 2106.01). In the sense used in the patent law (35 USC 101), a "format" is not functional because it is neither "tied to a particular apparatus" nor "operates to change materials to 'a different state or thing'" (/N

RE COM/SKEY, CAFC 2006-1286, September 2007) and does not distinguish the claimed product from otherwise identical prior art (MPEP § 2112.01.III). "Format" as software is not one of one of the four statutory categories of invention enumerated by 35 U.S.C. 101 (MPEP § 2106.IV.B). The arrangement of words or symbols on a page, including its format, constitutes printed matter and cannot patentably distinguish an invention over the prior art.

10. Similarly, claims 2-10 ("channel" has no special clear definition in the spec. and is interpreted as any means for communication), 29, 30, 35-37, 39, 46 and 55 contain only non-functional descriptive material and were not given patentable weight (MPEP § 2106.01).
11. Sheth also teaches at the citation given above claims 15-20, 33, 34, 40-42, 48, 49, 53 and 54.
12. Sheth also teaches claims 11-14, 50 and 51 (col. 16 lines 12-19 and 37-55). Sheth also teaches claims 23, 24, 26-28 and 43-45 as multiple "ads" (col 16 lines 12-19 and 37-55), where multiple keywords reads on "multiple items" and no weight was given to "additional ad" because it lacks clear definition the specification (MPEP § 2111.01), and there is no clear definition for the distinction between "content" and "ad". An "ad" is interpreted as anything that promotes, so "content" itself could be a first "ad".
13. Claims 21, 22, 25, 31, 32 and 52 are rejected under 35 U.S.C. 102(b) as being anticipated by Sheth et al. (US006311194B1, hereafter "Sheth") in view of official notice. Sheth does not teach targeting ads by geography or URL. Official notice is taken (MPEP § 2144.03) that these were common means of targeting ads at the time of the instant invention.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and informal fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
15. The examiner's supervisor, James W. Myhre, can be reached on 571-272-6722. The fax phone number for all *formal* fax communications is 571-273-8300.

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16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
17. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

24 September 2008

/Donald L. Champagne/
Primary Examiner, Art Unit 3688